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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,588	07/12/2001	Yoshikado Sanemitsu	50006-111	9436

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MCDERMOTT, WILL & EMERY  
600 13th Street, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

LE, UYEN CHAU N

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/902,588	SANEMITSU, YOSHIKADO
	Examiner Uyen-Chau N. Le	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

Re claim 1, line 9: Substitute “a mini-card” with -- the mini-card --.

Appropriate correction is required.

3. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 recites “a mini-card with a semiconductor device... manufactured by the method of claim 1,” and claim 1 recites “a method of manufacturing a mini-card with a semiconductor memory device”. Therefore, claim 4 does not further limit the subject matter of claim1. Appropriate clarification and correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,956,601) in view of Luvini et al (US 6,193,557).

Re claims 1 and 3-5, Sato et al discloses a method of manufacturing a card with a semiconductor device comprising providing an array of substrates including a plurality of individual substrates connecting together (see figs. 1a-1b); mounting a semiconductor memory device on each individual substrates (see figs. 1c-1d); covering the individual substrates with molding portions 3, which serves respective cases (see figs. 1c-1d) wherein the substrate is partially exposed outwardly of the case (see fig. 2a); and dividing the substrate array to provide encased individual substrates each completing the card having the semiconductor memory device embedded therein (see figs. 1a-3c; col. 3, line 55 through col. 5, line 32).

Sato et al fails to teach or fairly suggest that the card is a mini-card.

Luvini et al teaches the above limitation with mini-SIM card (col. 1, lines 23-39).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to substitute the chip card as taught by Sato et al with a mini-card in order to provide Sato et al with a more compact system, wherein a mini-card can be carried along with the user at all due to its mini size (e.g., the mini-card can be carried in a small pocket or wallet, etc.). Furthermore, such modification would have been an obvious extension as taught by Sato et al, well within the ordinary skill in the art, and therefore an obvious expedient.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al in view of Masahiko (US 5,852,289). The teachings of Sato et al have been discussed above.

Re claim 2, Sato et al has been discussed above but fails to teach or fairly suggest that each substrate is sandwiched between top and bottom case segments.

Masahiko teaches the above limitation with a substrate 122 having a semiconductor chip 123 mounted thereon being sandwiched between top 121b and bottom 121a case segments (see figs. 12b, 14a&b, and 18; col. 2, lines 11+ and col. 9, lines 24+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Masahiko into the teachings of Sato et al in order to provide Sato et al with a better protection of the chip module, preventing the chip from being damaged. Furthermore, such modification would provide Sato et al with a more accurate system, and thus providing a more user-friendly system. Accordingly, such modification would have been an obvious extension as taught by Sato et al, well within the ordinary skill in the art, and therefore an obvious expedient

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patents to Murohara (US 6,089,461); Iwasaki et al (US 6,137,710); DeFrasne et al (US 5,603,629); Hohmann et al (US 5,943,769); Hirai et al (US 6,308,894); Ohuchi (US 5,877,542); Fukuda (US 6,091,137); Nakai et al (JP 3-76691); and Isberner (DE 198 33 103) are cited as of interest and illustrate a similar structure to a PC adapter cards and method of manufacturing the same.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on M-T and TR-F 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*Uyen-Chau N. Le*

November 16, 2001



KARL D. FRECH  
PRIMARY EXAMINER